



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Jean MONDET et al.)
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Application No.: 09/964,751) Group Art Unit: 1616
)
Filed: September 28, 2001) Examiner: E. J. Webman
)
For: COSMETIC COMPOSITIONS) Confirmation No.: 3105
)
COMPRISING AT LEAST ONE)
CONTINUOUS LIQUID FATTY PHASE)
STRUCTURED WITH POLYURETHANES,) **MAIL STOP AF**
)
POLYURETHANEUREAS, AND)
POLYUREAS)

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated December 6, 2005, the period for response having been extended two months by the accompanying petition and fee to May 8, 2006 (as May 6, 2006, falls on a Saturday), Applicants respectfully request reconsideration of this application in view of the following remarks. A Notice of Appeal is filed concurrently herewith.

Claims 1-77 are pending in this application. Claims 9, 14-20, 22-38, 46-48, 51, 56, 62, 64, 66, and 73-76 have been withdrawn as directed to the non-elected subject matter. Therefore, claims 1-8, 10-13, 21, 39-45, 49, 50, 52-55, 57-61, 63, 65, 67-72,

and 77 are subject to examination and have been finally rejected. No amendments were made after the December 6, 2005 Final Office Action.

Rejection under § 103(a) Is Improper For Lack of Evidence of A Suggestion Or Motivation and Lack of A Reasonable Expectation of Success

The Examiner has maintained the rejection of claims 1-8, 10-13, 21, 39-45, 49, 50, 52-55, 57-61, 63, 65, 67-72, and 77 under 35 U.S.C. § 103(a) as unpatentable over Arnaud et al. (U.S. Patent No. 5,961,998) ("*Arnaud*") in view of Kantner et al. (U.S. Patent No. 6,433,073) ("*Kantner*"). Final Office Action, p. 2. This is the sole rejection in the Final Office Action. Applicants continue to respectfully traverse this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, including that (1) there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and (2) there must be a reasonable expectation of success for the modification or combination. M.P.E.P. § 2143. "Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

First, the Examiner has failed to point to any evidence of a suggestion or motivation to pick and choose the specific polyurethanes, which are soluble or dispersible in hydrocarbon-based oils, as recited in the rejected claims, from the polyurethanes disclosed in *Kantner*. *Kantner* discloses various polyurethanes in column

5, line 66 to column 12, line 20, but does not provide any suggestion or motivation to pick and choose the specific polyurethanes recited in the rejected claims.

Further, the Examiner has failed to point to any evidence of a suggestion or motivation to use the dispersion of *Kantner* in the lipstick of *Arnaud* to arrive at the presently claimed invention.

Kantner discloses “a stable polyurethane dispersion in [an] alcohol-water system.” *Kantner*, col. 1, lines 6-7 (emphasis added). *Kantner* teaches that “[s]table polyurethane dispersions in hydro-alcohol (i.e., alcohol-water) systems are especially difficult [to form].” *Id.* at lines 39-65 (emphasis added). *Kantner* further explains that one primary reason for the difficulty in forming a stable polyurethane dispersion in an alcohol-water system is that “the addition of lower alcohols (e.g., C₁ to C₄) to water decreases the surface tension of the solvent system. . . . The reduction in surface tension can affect the ability to self assemble hydrophilic and hydrophobic domains during the dispersion preparation.” *Id.* at lines 42-51. Therefore, as one of ordinary skill in the art would understand, although the polyurethane dispersion in the alcohol-water solvent system is stable as disclosed in *Kantner*, such a dispersion is not necessarily stable in a solvent system comprising water, alcohol, and other solvents, such as oils, because the surface tension of the original water-alcohol solvent system disclosed in *Kantner* would be disrupted by the addition of the other solvents, such as oils. Consequently, such disruption will destroy the stability of the polyurethane dispersion in the original water-alcohol solvent system.

Here, the cosmetic composition disclosed in *Arnaud* contains a liquid fatty phase comprising at least one aromatic group-containing oil, which is a solvent. *Arnaud*, col.

1, line 66 - col. 2, line 2. Therefore, given the fact that *Kantner's* polyurethane dispersion in an alcohol-water system is already stable and difficult to form, one of ordinary skill in the art would not have been motivated to combine *Kantner's* polyurethane dispersion in an alcohol-water system with *Arnaud's* composition, as such an alleged combination will introduce the aromatic group-containing oil in *Arnaud's* composition as a solvent into *Kantner's* dispersion system, likely destroying the already-existing and desired stability of *Kantner's* dispersion.

The sole reason alleged by the Examiner in support of the assertion that it would be obvious to use the dispersion of *Kantner* in the lipstick of *Arnaud* is "for the beneficial effect of forming a hydrophobic film." Final Office Action, p. 2. However, as clearly indicated in *Kantner*, and admitted by the Examiner, it is the stable polyurethane dispersion in the alcohol-water systems disclosed in *Kantner* that has the ability to form hydrophobic films. See *Kantner*, col. 5, lines 29-30; Final Office Action, p. 2. If the stability of the polyurethane dispersion in an alcohol-water system is destroyed by combining it with *Arnaud's* composition, the beneficial effect of forming hydrophobic films might not be achieved.

In addition, the Examiner has failed to point to any evidence of a reasonable expectation of success in using the dispersion of *Kantner* in the lipstick of *Arnaud* to form "the at least one continuous liquid fatty phase containing at least one hydrocarbon-based oil and structured with at least one polymer . . . said at least one polymer being soluble or dispersible in said at least one hydrocarbon-based oil" as recited in, for example, claim 1 of the present invention. Specifically, as discussed above, the teachings of the polyurethanes in *Kantner* are limited to the stable dispersion in the

alcohol-water system, which is difficult to form. Given the teachings of the polyurethanes in *Kantner*, there is no reasonable expectation of success to form a solution or dispersion of a polyurethane in a hydrocarbon-based oil as recited in the rejected claims by using the alcohol-water dispersion of *Kantner* in the lipstick of *Arnaud* as alleged by the Examiner. Therefore, this rejection is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the rejected claims.

If there is any additional fee due in connection with the filing of this paper, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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